



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,121	04/20/2005	Uwe Hering	449122080500	5812

25227 7590 10/05/2006

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102

EXAMINER

PHAN, THIEM D

ART UNIT PAPER NUMBER

3729

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/532,121	HERING ET AL.	
	Examiner	Art Unit	
	Tim Phan	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/19/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on 08/03/06 has been fully considered and made of record.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 8, are rejected under 35 U.S.C. 102(b) as being anticipated by Luzzi (US 5,864,942).

With regard to claim 1, Luzzi teaches a method for making high voltage switch or breaker pole (Fig. 1), comprising:

- producing a breaker (Fig. 1, 36) and a dimensionally stable sheath (Fig. 1, 10) independently from one another;
- fixing the breaker in the sheath (Col. 3, line 17)
- providing the cushioning (Col. 3, lines 18 & 19) by filling the intermediate space with a fluid compensating compound; and
- curing (Col. 6, lines 21-23) the compensating compound.

With regard to claim 8, Luzzi teaches that the connection part (Fig. 1, 58) is cast into the sheath (Fig. 1, 10 or 22) when the latter is produced.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luzzi.

With regard to claims 2 and 3, Luzzi teaches a method for making high voltage switch or breaker pole, including the steps of molding the fluid compensating compound or insert (Fig. 1, 32), which reads on applicants' claimed invention; except for having a casting channel for filling, located in the sheath or housing (Fig. 1, 10) or arranged below the immediate space of the insert for filling.

It is mere matter of design choice to have a casting channel for filling, located in the sheath or housing, or arranged below the immediate space of the insert for filling, since it is known in the art that the fluid compensating compound or insert has to be mold (Col. 9, lines 26-30) and it appears that the invention would perform equally well with the molding process taught

by Luzzi.

With regard to claims 6 and 7, Luzzi teaches a method for making high voltage switch or breaker pole, including the steps of molding the fluid compensating compound or insert (Fig. 1, 32) for curing (Col. 6, lines 20-23), which reads on applicants' claimed invention; except for having a casting channel for inserting the filler being sealed with insulating material after filling.

It would be obvious to one of ordinary skill in the art at the time the invention was made to seal the filling channel with an insulating material in order to cure the filling material.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luzzi in view of Seki et al (US 5,698,008).

Luzzi teaches a method for making high voltage switch or breaker pole, including the steps of molding the fluid compensating compound or insert (Fig. 1, 32) and applying a filling under some pressure (Col. 7, lines 33-37), which reads on applicants' claimed invention.

Seki et al teach a method of making vacuum valve by applying under vacuum atmosphere and molding pressure in order to improve the withstand voltage characteristic.

It would be obvious to one of ordinary skill in the art at the time the invention was made to combine the two teachings by applying the molding under vacuum and pressure, as taught by Seki et al, to the method of molding the fluid compensating compound or insert, as taught by Luzzi, in order to improve the withstand voltage characteristic of the insert.

Response to Arguments

7. Applicants' arguments (filed on 8/03/06) with respect to claims 1-8 have been considered but are moot in view of the new grounds of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Applicants' amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

Art Unit: 3729


examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M - F, 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Phan
Examiner
Art Unit 3729

tp
October 3, 2006



**A. DEXTER TUGBANG
PRIMARY EXAMINER**